

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/788,351
Attorney Docket No.: Q61689

REMARKS

Claims 1-24 and 26-29 are all the claims pending in the Application. By this Amendment, Applicant amends claim 23 to further clarify the invention. In addition, Applicant adds claim 30. Claim 30 is supported throughout the specification.

Summary of the Office Action

Claims 1-24 and 26-29 presently stand rejected. The Amendment under 37 C.F.R. § 1.116 filed on March 29, 2005 has been entered and the objection to claim 21 and the 35 U.S.C. § 112, second paragraph rejection of claims 10-12 has been withdrawn. The Examiner, however, maintained some of the rejections under 35 U.S.C. § 103(a) and rejected the new claim under 35 U.S.C. § 103(a). Specifically, the rejections are as follows:

a) claims 1, 2, 7-10, 13-16, 18-22, and 24-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,130,023 to Coppens et al. (hereinafter "Coppens") in view of U.S. Patent No. 4,376,816 to Hayashi et al. (hereinafter "Hayashi") and U.S. Patent No. 6,306,254 to Usui (hereinafter "Usui");

b) claims 3, 5, 11, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens, Hayashi, and Usui in view of Japanese Patent Abstract No. 03036545 to Goto et al. (hereinafter "Goto");

c) claims 4, 6, and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens, Hayashi, and Usui in view of U.S. Patent No. 5,729,962 to Dirx (hereinafter "Dirx") and Japanese Patent No. 8-39958 to Usui et al. (hereinafter "Usui 2");

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d) claim 23 is rejected under 35 U.S.C. § 103(a) as being obvious over Coppens and Hayashi in view of U.S. Patent No. 3,767,451 to Busch (hereinafter “Busch”); and

e) claims 28 and 29 are rejected under 35 U.S.C. § 103(a) as being obvious over Coppens in view of Hayashi.

Prior Art Rejections

The above-noted prior art rejections are respectfully traversed in view of the following remarks.

Hayashi, Coppens, and Usui

Claims 1, 2, 7-10, 13-16, 18-22, and 24-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens in view of Hayashi and Usui.

Independent claims 1, 2, 7, and 13 recite “wherein the density of the material is 0.7 to 0.85 grams per cubic centimeter.” The Examiner maintains that the combined teachings of Coppens in view of Hayashi and Usui disclose the unique features of claims 1, 2, 7, and 13. Specifically, the Examiner alleges that one of ordinary skill in the art would have been motivated to combine Usui with Hayashi because the air permeability is explicitly linked to the stabilization of sensitivity and as such would necessarily include the density as disclosed by Usui (*see* page 6 of the Office Action). That is, the Examiner alleges that ***a particular density would necessary flow from the air permeability*** disclosed by Usui. Applicant respectfully disagrees.

Applicant respectfully submits that the Examiner’s allegation that the density is linked to air permeability is a mere speculation. That is, no evidence is provided by the Examiner to link the density to air permeability. In fact, Applicant respectfully submits that ***density of an***

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interleaf is not linked to air permeability of the photosensitive printing plate material, as evidenced by the enclosed draft Declaration under 37 C.F.R. § 1.132. Applicant is in a process of finalizing the enclosed draft Declaration under 37 C.F.R. § 1.132 and the finalized and executed Declaration under 37 C.F.R. § 1.132 will be submitted in the very near future.

In other words, Applicant respectfully submits that although stabilizing the sensitivity of the printing plates may be a desirable characteristic, as alleged by the Examiner (see page 15 of the Office Action), Usui teaches that it is achieved by providing an interleaf with *an air permeability* of about 15 seconds to about 300 seconds (col. 2, lines 35 to 41). In other words, if one of ordinary skill in the art here to combine Usui with Hayashi and Coppens, to stabilize the sensitivity of the printing plates, *the air permeability of the interleaves would have been used and not the density of the interleaf*. In short, there is no motivation to combine the density of Usui with Hayashi and Coppens, as detailed in the Amendment under 37 C.F.R. § 1.116 filed on March 29, 2005 and in the Amendment under 37 C.F.R. § 1.111 filed on July 30, 2004.

Moreover, one of ordinary skill in the art would not have turned to a reference which deals with stabilizing sensitivity of the printing plates as taught by Usui when addressing a storage issue of a the photothermographic film as taught by Hayashi, as set forth on page 14 of the Amendment under 37 C.F.R. § 1.116 filed on March 29, 2005, which is incorporated herein by reference. In short, one of ordinary skill in the art would not have combined the references in the manner suggested by the Examiner. Therefore, claims 1, 2, 7, and 13 are believed to be patentable over the combined teachings of Hayashi, Coppens, and Usui.

In addition, independent claims 2 and 13 recite “at least one planographic printing plate comprising an aluminum substrate and an imaging surface for feeding through an automatic plate feeding mechanism”. The Examiner maintains that the packaging material with properties taught by Hayashi and Usui can be used to package the printing plates of Coppen by modifying the disclosure of the paper spacers. This position is inaccurate. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01(V).

For example, Hayashi teaches a packaging material for the photothermographic sheet material (or dry-type organic silver film). In other words, the object being stored is not a printing plate but a dry-type organic silver film. Although the feature of smoothness is considered in terms of placing a smooth sheet between the films, an index to evaluate storage performance is sensitivity. Hayashi does not address the density of the material or the relative humidity because these characteristics are not essential for storing the photothermographic film. On the other hand, the planographic printing plates are especially vulnerable to moisture and density.

If an interleaf sheet of Hayashi is applied to the printing plate of Coppens, air permeability will be excessively large and stability of sensitivity will not be maintained. Accordingly, applying the interleaf of Hayashi to the printing plate of Coppens would defeat the purpose of Hayashi, which is to evaluate storage performance based on sensitivity. Moreover, if an interleaf of Hayashi were somehow applied to the printing plate set forth in claims 2 and 13,

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the smoothness will be excessively large and peelability will considerably deteriorate, as evidenced by the draft Declaration under 37 C.F.R. § 1.132 submitted herewith (as explained above, finalized and executed declaration is in the process of being completed and will be submitted with the USPTO in the very near future). That is, if the interleaf of Hayashi is applied to the printing plate of Coppens, the storage of the printing plate of Coppens will be ineffective because the interleaf of Hayashi would be almost unpeelable from the printing plate of Coppens.

In other words, combining these three references in the manner suggested by the Examiner renders the disclosure in Hayashi useless as there will be excessive smoothness, lack of stability of sensitivity, and deterioration of peelability.

In short, the features of Hayashi's storing sheet for photothermographic film material and the features of Usui's interleafs for stabilizing the sensitivity of printing plates cannot be and should not be applied to the features of the paper spacers of Coppens. For at least these exemplary reasons, the combined teachings of Hayashi, Coppens, and Usui do not teach or suggest a packaging material for the planographic printing plates as set forth in the independent claims 2 and 13.

Dependent claims 8-10, 14-16, 18-22, and 24-27 are patentable at least by virtue of their dependency on independent claims 1, 2, 7, or 13.

Coppens, Hayashi, Usui, Goto, Dirx, and Usui 2,

The Examiner rejected claims 3, 5, 11, and 17 as being obvious over Coppens, Hayashi, and Usui in view of Goto and claims 4, 6, and 12 as being obvious over Coppens, Hayashi, and Usui in view of Dirx and Usui 2. The exemplary deficiencies of Hayashi, Coppens and Usui, as

set forth above, are not cured by Goto, Usui 2 and Dirx, either alone or in any conceivable combinations. Consequently, claims 3-6, 11, 12, and 17 are patentable over the applied references, at least by virtue of their dependency.

Coppens, Hayashi, and Busch

The Examiner rejected claim 23 as being obvious over Coppens and Hayashi in view of Busch. Specifically, the Examiner alleges that since Hayashi discloses a paper having smooth surfaces with Bekk smoothness of 5 to 10,000 seconds, then having two surfaces with different Bekk smoothness values is obvious (*see* page 3 of the Office Action). The Examiner further alleges that this structure would necessarily facilitate separation of the packaging material from the planographic printing plate during automatic feeding and prevents damage to the image surface of the printing plate (*see* page 4 of the Office Action). Applicant respectfully disagrees.

To begin, “[t]he mere fact that a certain thing *may* result from a given set of circumstances is not sufficient [to establish inherency]. . . . [t]hat which may be inherent is *not necessarily known*. [o]bviousness cannot be predicated on what is unknown.” In re Bond 15 USPQ2d 1566, 1569 (Fed. Cir. 1990). Since in Hayashi, *the two surfaces can have the same Bekk smoothness values*, it is not inherent that the two surfaces have different smoothness. Moreover, since the two surfaces can have the same Bekk smoothness values, it would *not necessarily follow* that separation of the packaging material is facilitated. In Hayashi, *two surfaces having different Bekk smoothness is not necessarily present*. In fact, Hayashi even fails to suggest the two surfaces having different smoothness values. Moreover, in Hayashi, there is no teaching or suggestion of determining the different Bekk smoothness of the two surfaces based on facilitating separation of

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the packaging material from the planographic printing plate during automatic feeding and based on preventing damage to the image surface of the printing plate.

Coppens only teaches having a printing plate with an aluminum hydrophilic base and placing interleaves between the plates. Hayashi only teaches having interleaves with smoothness value between 5 to 10,000 Bekk seconds. Busch only teaches a manifold paper coated with pressure ruptured materials. The combined teachings of these references would not have (and could not have) suggested to one of ordinary skill in the art to have a package material in which the surfaces have different Bekk smoothness values, and the values being determined based on separation of the interleaf from the printing material during automated feeding characteristics and based on preventing damage to the printing material characteristics.

As explained above, Hayashi does not disclose or suggest that there is a difference between respective sides of the film nor that there is a difference between respective sides of the paper inserted between films. That is, Hayashi does not disclose or suggest having respective sides of the printing plate being different as well as the respective sides of the protective sheet used. The respective different sides of the applied protective sheet are given specific characteristics in view of the respective required properties of the respective different sides of the printing plate, and it cannot be said that this is either taught or suggested by the cited references.

Specifically, while paper with smoothness of 3-900 seconds can be applied to the image forming surface of the printing plate, only paper with smoothness of 3-55 seconds can be applied to the opposite side to the image forming surface (that is, the non-image forming surface). This is due to the fact that it

becomes necessary in an apparatus using such a printing plate for the positioning of one surface of the printing plate at the supply side to be controlled by a mechanism.

Therefore, for at least these exemplary reasons, claim 23 is patentable over the combined teachings of Hayashi, Coppens, and Bush. It is appropriate and necessary for the Examiner to withdraw this rejection of claim 23.

Coppens and Hayashi

With respect to claim 28, the Examiner maintains that “a means for preventing peeling of the imaging surface of said at least one planographic printing plate when the imaging surface is fed through the feeding mechanism” is disclosed by Coppens’ paper spacer. That is, the Examiner alleges that the paper spacer must necessarily prevent peeling. Applicant respectfully disagrees.

In construing a means-plus-function claim limitation, the PTO should first define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 [58 USPQ2d 1801, 1806] (Fed. Cir. 2001). In Coppens, there is no disclosure or suggestion that the paper spacer will prevent peelability of the imaging surface. If the Examiner takes the position that any paper spacer will prevent peelability, it is respectfully requested that this speculation be supported with evidence such as prior art references.

It is Applicant’s position that the paper spacer may be placed for a number of reasons such as to allow a machine to identify one printing sheet from another, guard against moisture, or to simply separate one printing sheet from another. It ***does not follow***, however, ***that each and every spacer will prevent peelability of the plates.***

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In short, the combined teachings of Coppens and Hayashi fail to teach or suggest “a means for preventing peeling of the imaging surface of said at least one planographic printing plate when the imaging surface is fed through the feeding mechanism.” For at least this exemplary reason, it is appropriate and necessary for the Examiner to withdraw this rejection of claim 28.

Claim 29 depends on claim 23. Accordingly, at least by virtue of its dependency, claim 29 cannot be rejected as being obvious in view of Coppens and Hayashi. That is, since independent claim 23 is rejected as being obvious over Coppens and Hayashi in view of Busch, by virtue of its dependency claim 29 is patentable over Coppens and Hayashi.

New Claim

New claim 30 is patentable at least by virtue of its dependency on claim 1.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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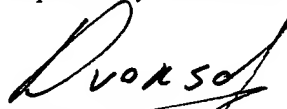
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Date: March 22, 2006

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